SUBJECT INDEX

	Page
Petition for Writ of Certiorari	1-13
References to Opinions in Courts Below	1
Grounds on Which Jurisdiction of Supreme Court is Invoked	2
Questions Presented for Review	5
Statutory Provisions Involved	5
Statement of Facts	6
Argument	9
Question I	9
Question II	11
Conclusion	13
Appendix	15-33
Opinion of the U. S. Court of Appeals for the Fifth Circuit	15-23
Judgment (Extract from the Minutes of July 30, 1954)	25
Petition for Rehearing	27
Order Denying Rehearing	33

TABLE OF CASES CITED

American Auto Association v. Spiegel, 205 F. 2nd 771, 346 U.S. 887	3, 10
California Fruit Growers Exchange v. Sunkist Baking Co., 205 F. 2nd 771, 346 U.S. 887	4, 11
S. C. Johnson & Sons v. Johnson, 116 F. 2nd 427, 175 F. 2nd 176, 338 U.S. 860, 94 L. Ed. 527, 70 S. Ct. 102	12
Staufer v. Exley, 184 F. 2nd 962	10

IN THE

SUPREME COURT OF THE UNITED STATES

No._____

PURE FOODS, INC.,

Petitioner,

vs.

MINUTE MAID CORPORATION,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

TO: The Honorable Earl Warren, Chief Justice of the United States, and the Associate Justices of the Supreme Court of the United States:

The petitioner respectfully shows:

REFERENCES TO OPINIONS IN COURTS BELOW

This is a petition to the Supreme Court of the United States for writ of certiorari to review the judgment of the United States Court of Appeals for the Fifth Circuit rendered July 30, 1954, not yet reported, (rehearing denied

August 31, 1954), affirming a judgment of the United States District Court for the Southern District of Florida rendered and filed July 27, 1953, and amended by order entered the same date (also, not reported).

The judgment of the United States District Court is set forth in the transcript, filed herewith, at pages 19 to 21, inclusive.

The order of the United States District Court amending said judgment is set forth in the Transcript at pages 21 and 22.

The opinion and judgment of the United States Court of Appeals are set forth in the said Transcript at pages 185 to 195, inclusive, and in the appendix.

The Order of the United States Court of Appeals denying the defendant's petition for rehearing is set forth in said Transcript at page 203, and in the appendix. The petition for rehearing is set forth in the appendix.

This case is based upon the Lanham Act, 15 U.S.C.A. 1051, et seq.

GROUNDS ON WHICH JURISDICTION OF SUPREME COURT IS INVOKED

The petitioner invokes the jurisdiction of the Supreme Court of the United States on the following grounds:

1. The judgment of the United States Court of Appeals in this case is in direct conflict with the decision of the United States Court of Appeals for the Second Circuit

in the case of *American Auto Association v. Spiegel*, 205 F. 2nd 771, certiorari denied November 16, 1953, 346 U.S. 887. In the case at bar, the Court of Appeals held that purely intra-state infringement of a trademark registered under the Lanham Act would be enjoined upon showing of confusion as to source of origin of the goods involved, without any separate showing of substantial effect upon interstate commerce. In the American Auto Association case, supra, the Court held that the expansion of the federal jurisdiction by the Lanham Act was not so broad as to do so.

2. The United States Court of Appeals has in this case decided an important question of federal law which has not been, but should be, settled by this Court, to-wit: the question of whether or not federal courts have jurisdiction under the Lanham Act to enjoin acts occurring wholly in intrastate commerce, which cause confusion as to the source of origin of the alleged infringer's goods, but do not have any substantial effect on interstate commerce, or interfere with the free flow of interstate commerce in general, or interfere with the free flow in interstate commerce of goods protected by a registered trademark. In addition to the different conclusions reached in United States Courts of Appeals, many United States district courts have also adopted conflicting conclusions on the jurisdictional question raised by this petition. In view of the ever-growing registration of trademarks, businesses protected by trademarks and litigation involving trademarks and unfair competition, the question presented by this petition ought to be settled by the Supreme Court to the end that considerable unnecessary litigation and expense will be avoided.

3. The judgment of the Court of Appeals is in direct conflict with the decision of the United States Court of Appeals for the Seventh Circuit in the case of *California Fruit Growers Exchange v. Sunkist Baking Co.*, 166 F. 2nd 971, which held that a registered trademark should be confined substantially to the articles for which the trademark was authorized. In the case at bar, the Court of Appeals has extended the right to the registered name itself without limitation to the products for which the trademark was registered.

4. The judgment of the United States Court of Appeals is contrary to law in that it holds that federal courts do have jurisdiction to enjoin alleged infringement of a registered trademark committed wholly in intrastate commerce and not in "commerce" as defined by the Lanham Act. Even if the American Auto Association case, supra, is distinguishable from the case at bar, as the Court of Appeals has apparently attempted to make it, the ruling of the Court of Appeals is contrary to law and is unwarranted.

The judgment of the United States Court of Appeals sought to be reviewed was filed July 30, 1954.

The defendant's petition for rehearing was denied by the United States Court of Appeals on August 31, 1954, and said order was entered the same date.

The petitioner believes that 15 U.S.C.A., sec. 1122, confers jurisdiction on this Court to review the judgment of the United States Court of Appeals in question.

QUESTIONS PRESENTED FOR REVIEW

I.

Does the federal court have jurisdiction to enjoin the alleged infringement of a trademark registered under the Lanham Act where the acts of alleged infringement occurred wholly in intrastate commerce, did not have any substantial economic effect on interstate commerce or interfere with the free flow of interstate commerce in general, did not interfere with the free flow in interstate commerce of the goods protected by the registered trademark, but merely caused confusion as to the source of origin of the alleged infringer's goods?

II.

Where the registered trademark is limited solely to frozen fruit juice concentrates and the alleged infringing trademark is used only in intrastate commerce and solely in connection with frozen meats and meat products, and there is consequently no competition between the users of the respective trademarks, is there, as a matter of law, actionable confusion which federal courts have the right to enjoin under the Lanham Act?

STATUTORY PROVISIONS INVOLVED

The jurisdiction of the federal courts to enjoin the alleged acts of infringement here involved, if such jurisdiction exists at all, arises from the following federal statutes, being a portion of the "Lanham Act":

15 U.S.C.A., 1114:

"(1). Any person who shall, in commerce, (a) use, without the consent of the registrant, any

reproduction, counterfeit, copy, or colorable imitation of any registered mark in connection with the sale, offering for sale, or advertising of any goods or services on or in connection with which such use is likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods or services; or (b) reproduce, counterfeit, copy, or colorably imitate any such mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles, or advertisements intended to be used upon or in connection with the sale in commerce of such goods or services, shall be liable to a civil action by the registrant for any or all of the remedies hereinafter provided, except that under subsection (b) hereof the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such mark is intended to be used to cause confusion or mistake or to deceive purchasers."

(2). Is not pertinent to this petition.

15 U.S.C.A., 1127:

" . . . . . The word 'commerce' means all commerce which may lawfully be regulated by Congress. . . . . " (other portions of section omitted as not pertinent.)

STATEMENT OF FACTS

The petitioner, Pure Foods, Inc., was the defendant in the original action, and the respondent, Minute Maid Corporation, was the plaintiff.

Both plaintiff and defendant are Florida corporations, and there is, consequently, no diversity of citizenship.

Respondent is engaged in the business of manufacturing and selling frozen fruit juice concentrates in interstate commerce both to and from the State of Florida, (Tr. 2).

Petitioner is engaged in the business of manufacturing and selling frozen meats and meat products solely within the State of Florida. Respondent's complaint does not allege that any of petitioner's acts were done "in commerce", (Tr. 1-4), nor does the evidence show any business of the petitioner other than in intrastate commerce.

Petitioner's Florida trademark of "Minute Made Quality Frozen Meat Products" was registered in Florida on or about August 13, 1951, (Tr. 12).

Respondent's trademark, "Minute Maid", was registered under the Lanham Act on February 19, 1952, for frozen concentrated juices of citrus fruits, (Tr. 11).

Respondent's frozen juice products are distributed through brokers, wholesalers or jobbers of frozen fruit products to retail stores, which in turn sell to the consuming public. (Tr. 13).

Petitioner's frozen meats and meat products are manufactured in Miami, Florida, and sold directly to retail stores, and not through brokers, wholesalers, or jobbers, (Tr. 22). All of petitioner's packages are clearly marked to show that they are manufactured by Pure Foods, Inc., of Miami, Florida, (Tr. 68-69).

The pleadings and the evidence are entirely devoid of any allegation or proof that petitioner has ever in any way engaged in "commerce" as defined by the Lanham Act; or that petitioner's business has any economic effect, substantial or otherwise, on interstate commerce; or that petitioner's business in any way interferes with the free flow of respondent's goods in interstate commerce. Respondent charged only that petitioner's use of the name "Minute Maid" was fraudulent and "with the intention of deceiving the purchasing public" and damaging plaintiff's good will and reputation . . . .", (Tr. 4).

The District Court, among other things, found, (Par. 14, Tr. 13), that "Defendant's use of the words 'Minute Made' has caused confusion and mistake on the part of purchasers as to the source of origin of defendant's products. The use of such words is likely to continue to cause confusion and mistake in the minds of the general public."

The District Court further found:

A. That "there is no evidence that defendant adopted the words 'Minute Made' with the actual or wilful intention to mislead or confuse the public.", (Par. 15, Tr. 13).

B. That plaintiff's and defendant's products were not being sold in competition with one another., (Par. 16, Tr. 14).

C. That plaintiff had suffered no damages. (Par. 3, Tr. 14).

There being no diversity of citizenship, Respondent's

case depends entirely upon the Lanham Act to vest the federal court with jurisdiction. Petitioner's contention is, of course, that the Lanham Act does not extend jurisdiction to the controversy existing under the facts of this case.

ARGUMENT

> *Question I:* Does the federal court have jurisdiction to enjoin the alleged infringement of a trademark registered under the Lanham Act where the acts of alleged infringement occurred wholly in intrastate commerce, did not have any substantial economic effect on interstate commerce or interfere with the free flow of interstate commerce in general, did not interfere with the free flow of interstate commerce of the goods protected by the registered trademark, but merely caused confusion as to the source of origin of the alleged infringer's goods?

This is the prime question presented by this petition.

It is elementary that the commerce which Congress has the power to regulate is interstate commerce. This basic principle has been expanded to hold that intrastate commerce may be regulated by Congress where that intrastate commerce substantially affects or interferes with the free flow of interstate commerce. Such a view is reasonable and necessary. However, Congress has yet to expand, or even to attempt to expand, this basic right to the power to govern all intrastate commerce which merely competes with interstate commerce in a given locality, but does not affect the interstate business or interfere with its free flow in some substantial measure.

Congress has most clearly stated, in 15 U.S.C.A., 1114, supra, that for the remedies specified elsewhere in the Lanham Act to be available, the use of the registered mark must be likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods or services as are involved AND that the use must be "in commerce". The trial court found that petitioner's use of the words "Minute Made" had caused confusion and mistake on the part of purchasers as to the source of origin of respondent's products, but nowhere is there any finding, or evidence on which to base such a finding, that the petitioner's use of the mark was "in commerce".

The Court of Appeals has, therefore, held that mere confusion as to the source of origin of the products is sufficient to vest jurisdiction in the federal court, even though the alleged infringement occurred entirely in intrastate commerce, as long as the registered trademark is used in interstate commerce. And this is true without regard to any effect of substantial consequence on the business protected by the registered trademark. In other words, a registered trademark under the Lanham Act is entitled to protection of federal remedies against any business wholly intrastate. This broadened interpretation, which has admittedly been adopted in the Ninth Circuit, *Staufer v. Exley*, 184 F 2nd 962, was repudiated by the United States Court of Appeals for the Second Circuit in the case of *American Auto Association v. Spiegel*, supra, in which Judge Learned Hand, speaking for the Court, said:

> "We are forced to the conclusion that the Act does not give jurisdiction to the district courts over an action brought by any plaintiff with whose interstate commerce the defendant has unfairly competed."

The decision here sought to be reviewed has the effect of eliminating the requirement that the infringement be in commerce, even though the court conceded in its opinion that the infringement must be in commerce if the federal court is to have jurisdiction. The legal effect of such decision is to hold that the district court has jurisdiction of every infringement case under the Lanham Act where the infringement of the registered trademark causes confusion as to the origin of the infringer's goods, even though the infringement and the infringing business are wholly intrastate, and there is no showing of any effect on interstate commerce beyond the inferred damage to the name and good will of the owner of the registered mark. Such damage, if automatically inferred, would exist in every case as a matter of law without proof, and it must also be inferred that such inferred damage would have some substantial effect on interstate commerce, also without any requirement of proof on the point.

> *Question II:* Where the registered trademark is limited solely to frozen fruit juice concentrates and the alleged infringing trademark is used only in intrastate commerce and solely in connection with frozen meats and meat products, and there is consequently no competition between the users of the respective trademarks, is there, as a matter of law, actionable confusion which federal courts have the right to enjoin under the Lanham Act?

This quesiton is also of paramount importance, and presents another serious problem upon which United States Courts of Appeal are at odds.

In the California Fruit Growers Exchange case, supra,

the court dealt with the suit of the owners of the trademark "Sunkist", registered to cover fruits and vegetables, to enjoin the use of the registered name in the sale of bread. The products of the respective parties were sold through retail stores to ultimate consumers, as is the case here. There is no more difference between fruits and vegetables on one hand and bread on the other than there is in frozen fruit juice concentrates on one hand and frozen meats on the other. The court (Minton, J.) refused to enjoin the use of "Sunkist" in the sale of bread, and stated:

> "The unconscionable efforts of the plaintiffs to monopolize the food market by the word 'Sunkist' on all manner of goods sold in the usual food stores should not be sanctioned by the courts. The trademarks should be confined substantially to the articles for which they were authorized, otherwise, why limit the marks at all?"

The court also said:

> "The mere use of a name which the defendants had a right to use does not in and of itself constitute unfair competition."

In the case of *S. C. Johnson & Son v. Johnson*, 116 F. 2nd 427, same case reported at 175 F. 2nd 176, certiorari denied, 338 U.S. 860, 94 L. Fed. 527, 70 S. Ct. 102, the court (L. Hand, J.), in dealing with the right of the owner of the trademark "Johnson's", registered in connection with cleaners, polishes and waxes, but not fabric cleaners, to enjoin the use of such name in connection with the sale of fabric cleaners, refused to extend the right, and said:

"If Congress really meant to allow every first user of a mark so to stifle all excursions into adjacent markets upon showing no more than that confusion would result, it seems to us that it would have said so more clearly."

The court in this case further stated:

"The public may be deceived, but he has no claim to be its vicarious champion; his remedy must be limited to his injury and by hypothesis he has none. There is always the danger that we may be merely granting a monopoly, based upon the notion that by advertising one can obtain some 'property' in a name. We are nearly sure to go astray in any phase of the whole subject, as soon as we lose sight of the underlying principle that the wrong involved is diverting trade from the first user by misleading customers who mean to deal with him. Unless therefore he can show that, in order to hold or develop his present business, he must preserve his identity in the disputed market, he cannot rely upon the second of the two interests at stake."

CONCLUSION

It is respectfully urged that the decision of the United States Court of Appeals in this case should be reviewed on writ of certiorari, and the cause reversed by reason of the erroneous rulings of law therein made.

WILLIAM C. MARTIN and JOE CREEL
Counsel for Petitioner

By_____

CERTIFICATE OF MAILING

I do hereby certify that the above and foregoing Petition for Writ of Certiorari was served upon J. Thomas Gurney, Esq., 413 First National Bank Building, Orlando, Florida, and upon Ralph L. Chappell, Esq., 165 Broadway, New York 6, New York, as Attorneys for the Respondent, by depositing the same properly addressed in a United States mail box, with air mail postage prepaid, this_____ day of_____, 1954.

WILLIAM C. MARTIN and JOE CREEL
Counsel for Petitioner

By_____

APPENDIX

Opinion of the Court — Filed July 30, 1954.

IN THE UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 14805

PURE FOODS, INC.,

Appellant,

versus,

MINUTE MAID CORPORATION,

Appellee.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF FLORIDA.

July 30, 1954)

Before HUTCHESON, Chief Judge; RIVES, Circuit Judge; and RICE, District Judge.

RIVES, Circuit Judge: The defendant[1] is appealing from a judgment in favor of the plaintiff in an action for infringement of a trade-mark registered under the Lanham Act, 15 U.S.C.A. 1051, et seq. The complaint alleges the manufacture and sale by the plaintiff in interstate commerce to and from the State of Florida of frozen fruit juice concentrates uder the trade-mark "Minute Maid",

[1]For clarity the parties will usually be referred to as plaintiff and defendant.

and also alleges the registration of said trade-mark under the Lanham Act, and that the defendant has violated the plaintiff's rights in the trade-mark and has unfairly competed with plaintiff by selling frozen meats under the designation "Minute Made".

Each party is a Florida corporation and jurisdiction, though not questioned in the district court, depends upon the Lanham Act.

The district court made findings of fact[2] and conclu-

---

2 "FINDINGS OF FACT"

"1. The Court has jurisdiction of the subject matter and parties.

"2. On February 19, 1952, plaintiff was granted Certificate of Trade Mark Registration No. 555,105, by the United States Patent Office for frozen concentrated juices of citrus fruits, in Class 46, Foods and Ingredients of Foods, such trade mark consisting of the words 'Minute Maid'.

"3. Plaintiff first used such trade mark in commerce on or about April 30, 1946, and has been continuously using same in commerce to identify its products since that date.

"4. Such trade mark was registered with the Secretary of State of the State of Florida by plaintiff on or about December 1, 1949, and had been used by plaintiff or its predecessor in the State of Florida since 1945, and Plaintiff has continuously used such trade mark in said State since that time.

"5. On or about August 13, 1951, the defendant caused to be registered its trade mark, design and insignia with the Secretary of State of the State of Florida, and has continuously used such trade mark since that time. Such trade mark consists, in part, of the words 'Minute Made'.

"6. Defendant has never been granted a certificate of trade mark registration by the United States Patent Office, nor have they ever applied for such certificate.

"7. Plaintiff does not and has never sold frozen meats or frozen meat products and has only sold, under its trade mark, frozen fruit juices and concentrates.

"8. Defendant does not and has never sold frozen fruit juice concentrates and has only sold frozen meats or frozen meat products.

"9. The plaintiff has spent large sums in advertising its products under the name 'Minute Maid', its current advertising budget being approximately $1,500,000.00 per year. This advertising has been through various mediums, including radio, television, magazines, newspapers, etc.

"10. The defendant has done very little advertising of its products.

"11. Plaintiff's and defendant's products are sold to the same class of user, to-wit, housewives, and are sold by the same outlets, retail grocery stores. In such stores, generally, both plaintiff's and defendant's products are sold from the frozen food departments and are displayed in the same general location.

sions of law,[3] and enjoined the defendant from selling frozen meats under the designation "Minute Made", but without any accounting for damages or profits.

The specifications of error may be divided as between objections to the jurisdiction and to the judgment on its merits as follows:

1. *Jurisdiction.* The district court lacked jurisdiction because:

---

3 *(Continued)*

"12. Generally, plaintiff's products are distributed to the retail stores through brokers, wholesalers or jobbers of frozen foods, and defendant's products are distributed directly by defendant, to the retail stores. Generally, those companies producing and distributing both fresh and frozen meats, channel their frozen meats through frozen food distributors as distinguished from their fresh meat distribution outlets.

"13. The words 'Minute Maid' have acquired secondary meaning in the mind of the public as denoting products produced and sold by the plaintiff.

"14. Defendant's use of the words 'Minute Made' has caused confusion and mistake on the part of purchasers as to the source of origin of defendant's products. The use of such words is likely to continue to cause confusion and mistake in the minds of the general public.

"15. There is no evidence that defendant adopted the words 'Minute Made' with the actual or wilful intention to mislead or confuse the public.

"16. Plaintiff's and defendant's products, not being sold in actual competition one with the other, defendant's action has not deprived the plaintiff of sales of any of its products.

"17. There was no proof of actual monetary damage or injury as a result of defendant's actions to the good will or business of the plaintiff."

---

3 "CONCLUSIONS OF LAW"

"1. Confusion, not competition, is the real test of trade-mark infringement. It is a question as to whether the use of the words 'Minute Made' by defendant is likely to cause confusion or mistake or to deceive purchasers as to the source of origin of defendant's goods.

"2. Defendant, by the use of the words 'Minute Made', has infringed upon the trade-mark of the plaintiff, and plaintiff is entitled to an injunction restraining such infringement.

"3. Since plaintiff has suffered no loss or profits as a result of defendant's action and has suffered no monetary loss to its good will or business by reason thereof, no accounting of damages is required and an accounting should be denied.

"4. Plaintiff should have and recover of the defendant its costs in this action, but such costs should not include its attorneys' fees, or any expenses of its officers incurred as a result of their attendance at the trial of this cause.

"Counsel for plaintiff will present order consistent herewith."

(a) The pleadings and proof did not show that the defendant used its alleged infringing trade-mark "in commerce" within the meaning of the Lanham Act.

(b) The claim under the Lanham Act was not so substantial as to support pendent jurisdiction of the related claim for unfair competition.

2. *The Merits.* The district court erred in enjoining the defendant from using its trade-mark because:

(a) The judgment enlarges the plaintiff's trade-mark rights which were limited to fruit juice concentrates.

(b) When the parties are not in competition and neither causes damage to the other, (1) there cannot be confusion or likelihood of confusion as to the origin of the products, (2) the plaintiff has no authority to act as a vicarious champion to protect the public from any confusion.

(c) The words "Minute Made" were descriptive of the products of the defendant.

In defining infringement under the Lanham Act, 15 U.S.C.A. 1114 begins as follows:

> "(1) Any person who shall, in commerce, (a) use, without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of any registered mark in connection with the sale, offering for sale, or advertising or any goods or services on or in connection with which such use is likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods or services; * * *."

To be guilty of infringement of a registered mark under this statute the defendant must use the infringing mark "in commerce". 15 U.S.C.A. 1127 provides: "In the construction of this chapter, unless the contrary is plainly apparent from the context—*** The word 'commerce' means all commerce which may lawfully be regulated by Congress." It is too well settled to require citation of authority that an activity local in nature but which interferes with the free flow of interstate commerce or exercises a substantial economic effect on interstate commerce may be regulated by Congress. Under the rationale of the decision of this Court in *Bulova Watch Co. v. Steele*, 194 F. 2d 567, the Lanham Act extends jurisdiction to interstate infringement which has a substantial economic effect on interstate commerce. In affirming that decision, the Supreme Court recognized that the Lanham Act had broadened the scope of trade-mark jurisdiction. To declare that a trade-mark registered under the Lanham Act is protected from infringement which is purely intrastate but which interferes with the free flow of interstate commerce or has a substantial effect on such commerce is very different from the sweeping extension of the jurisdiction of federal courts to all instances of unfair competition with interstate commerce, though not affecting a Federally registered trade-mark, which was denied in the well considered opinion by Judge Learned Hand in *American Auto Association v. Spiegel*, 2nd Cir., 205 F. 2d. 771, certiorari denied 346 U.S. 887. In the light of the discussion in that opinion, and of the extreme breadth of extension of federal jurisdiction there attempted, it may well be that a consideration of other parts of the Act requires a restriction upon the broad statutory definition of "commerce" in cases of simple unfair competition, but that definition applies, we think, in cases of infringement of a trade-mark registered under the terms of the Act.

We think that the complaint, not attacked in the district court, sufficiently invokes that court's jurisdiction. While it does not charge that the defendant distributes its products in interstate commerce, and does not charge infringement "in commerce" in so many words, it does allege damage to plaintiff's good will established in interstate commerce.

The court has jurisdiction of the case actually proved under that complaint. The district court found that the plaintiff's trade-mark "Minute Maid" was registered under the Lanham Act, had been continuously used in commerce for many years, had acquired a secondary meaning in the mind of the public as denoting products sold by the plaintiff, and that defendant's use of the words "Minute Made" had caused confusion and mistake on the part of purchasers as to the source of origin of defendant's products, and that continued use of such words is likely to continue to cause confusion and mistake. We think that the infringement would subject the good will and reputation of the plaintiff's trade-mark to the hazards of the defendant's business, and that the district court had jurisdiction to protect the Federally registered trade-mark.

So holding, it is not necessary for us to consider the question of pendent jurisdiction of the claim of unfair competition within the provisions of 28 U.S.C.A. 1338(b).[4]

---

[4]"Section 1338(b) The district courts shall have original jurisdiction of any civil action asserting a claim of unfair competition when joined with a substantial and related claim under the copyright, patent or trade-mark laws."

Compare Pure Oil Co. v. Puritan Oil Co., 2nd Cir., 127 F. 2d 6; American Auto Association v. Spiegel, supra, at p. 775.

Coming to the merits, it is true that an applicant registers a trade-mark in connection with particular goods specified in the certificate of registration, 15 U.S.C.A. 1051, 1057. Plaintiff's registered trade-mark is limited to frozen juice concentrates. The remedies of an owner of a registered trade-mark, however, are not limited to the goods specified in the certificate but extend to any goods on which the use of an infringing mark "is likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods." 15 U.S.C.A. 1114(1). The Lanham Act thus adopts the principle stated in A.L.I. Restatement of Law of Torts, Vol. III, Sec. 730, pp. 597, 598, Sec. 731.

> "One's interest in a trade-mark or trade name came to be protected against simulation, **not only on competing goods, but on goods so related in the market to those on which the trade-mark or trade name is used that the good or ill repute of the one type of goods is likely to be visited upon the other. Thus one's interest in a trade-mark or trade name is protected against being subjected to the hazards of another's business."

A factual issue is necessarily presented as to what goods meet that description. *John Walker & Sons v. Tampa Cigar Co.*, 5th Cir., 197 F. 2d 72, 74; *Chappell v. Goltsman*, 5th Cir., 197 F. 2d 837, 838; A.L.I. Restatement of the Law of Torts, Vol. III, Sec. 731, p. 600. In the cases relied on by the defendant,[5] that factual issue was determined in favor of the defendants, while here it has been decided by the district court in favor of the plaintiff.

---

[5]California Fruit Growers Exchange v. Sunkist Baking Co., 7th Cir., 166 F. 2d 971, 975; and Curtis-Stephens-Embry Co. v. Pro-Tek-Toe Skate Stop Co., 8th Cir., 199 F. 2d 407, 415.

The appellant-defendant insists, however, that there cannot be confusion or likelihood of confusion as to the origin of the products when the parties are not in competition and neither causes damage to the other. The district court did not find that there was no damage or likelihood of damage, but merely found that "There was no proof of actual monetary damage or injury as a result of defendant's actions to the good will or business of the plaintiff." For that reason, the district court did not order an accounting. The district court further found:

> "Defendant's use of the words 'Minute Made' has caused confusion and mistake on the part of purchasers as to the source of origin of defendant's products. The use of such words is likely to continue to cause confusion and mistake in the minds of the general public."

It is difficult for the owner of a trade-mark to prove the amount of his damage or how much of it is caused by the infringement. To authorize preventive relief through the issuance of an injunction proof of actual damage is not necessary, but the likelihood of damage is sufficient. See 15 U.S.C.A. 1114(1); A.L.I. Restatement of the Law of Torts, Vol. III, Sec. 744, p. 631; 28 Am. Jur., Injunctions, Sec. 30. Without expressing any opinion on the cases from the Second Circuit establishing what the defendant refers to as the Learned Hand doctrine,[6] that, though the public may be deceived, the plaintiff has no claim to be its vicarious champion, we think that in this case there

---

[6] S. C. Johnson & Son v. Johnson, 2nd Cir., 116 F. 2d 427, Id. 175 F. 2d 176, cert. denied 338 U.S. 860, 94 L. Ed. 427, 70 S. Ct. 102;

Hyde Park Clothes v. Hyde Park Fashions, 2nd Cir., 204 F. 2d. 228. See especially the strong dissenting opinion of Judge Clark in the last cited case, 204 F. 2d at p. 226, et seq.

was sufficient likelihood of damage to the plaintiff to justify enjoining the infringement. Both parties sell frozen food products. Some companies have expanded their business so as to include many such products. Plaintiff's frozen fruit juice concentrates and defendant's frozen meats are both purchased by common purchasers, housewives, through common outlets, retail stores, and are displayed in the frozen food departments in those stores, often in locations not far apart. A number of housewives testified to their actual confusion and mistake in buying the defendant's products or their faith in the plaintiff's reputation.

The defendant, by motion, requested a finding that the words "Minute Made" were used by the defendant to describe its products, and the district court denied the motion. See 15 U.S.C.A. 111 5(b)(4). Defendant argues that "minute" refers to the time for cooking the meats and "made" means that the meats are processed. While all of defendant's products are processed, they could not truly be described as "made" meat. It took much longer than a minute to cook or prepare for serving most of the defendant's products. Altogether, this, like most of the other questions presented by the appellant-defendant, was a factual issue, and we cannot say that the district court's refusal to make a finding or its findings of fact are clearly erroneous. Rule 52(a) F.R.C.P.

The judgment of the district court is

AFFIRMED.

JUDGMENT.

Extract from the Minutes of July 30, 1954.

PURE FOODS, INC.

No. 14805 versus

MINUTE MAID CORPORATION.

This cause came on to be heard on the transcript of the record from the United States District Court for the Southern District of Florida, and was argued by counsel;

On consideration whereof, It is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be, and the same is hereby, affirmed;

It is further ordered and adjudged that the appellant, Pure Foods, Inc., and the surety on the appeal bond herein, Fidelity and Deposit Company of Maryland, be condemned, in solido, to pay the costs of this cause in this Court, for which execution may be issued out of the said District Court.

UNITED STATES COURT OF APPEALS
FIFTH CIRCUIT

NO. 14,805

PURE FOODS, INC.,

Appellant,

versus

MINUTE MAID CORPORATION,

Appellee.

PETITION FOR RE-HEARING.

The appellant, PURE FOODS, INC., a Florida corporation, respectfully petitions the Court for a re-hearing upon its decision in the above cause as evidenced by its opinion of July 30, 1954, on the following grounds:

1. The Court held in its said opinion, in determining the jurisdiction of the district court, as follows:

a. The statutory definition of "commerce" applies in trade-mark infringement cases under the Lanham Act requiring the infringement to be in "commerce".

b. Damage to Plaintiff's good-will established in interstate commerce constitutes infringement in "commerce", even though the infringement by Defendant and its business are both intrastate.

c. Confusion and likelihood of continued confusion as to source of origin of goods, as a matter of law, constiutes damage to Plaintiff's good-will established in "commerce", in that the good-will and reputation of Plaintiff's trade-mark are thereby subjected to the hazard of Defendant's business

The Court overlooked and failed to take into consideration the following:

a. The district court found as a matter of fact (1) The Defendant did not deprive Plaintiff of any sale, and (2) The Plaintiff suffered no loss of profits or monetary loss to its good-will or business. (Findings of Fact 16 and Conclusions of Law 3 set out in Court's opinion).

b. Such findings of fact of the district court, affirmed by the Court in its opinion, are inconsistent with the finding of the Court, as a matter of law, that there was damage to Plaintiff's good-will established in "commerce".

2. The Court overlooked and failed to take into consideration that the legal effect of its opinion is to establish as a matter of law in this circuit that a district court has jurisdiction of every trade-mark infringement case under the Lanham Act where the infringement of the trademark established in interstate commerce causes confusion as to the origin of Defendant's goods, even in cases where the infringement and the business of the Defendant are both intrastate.

3. The Court overlooked and failed to take into consideration that under its opinion no Plaintiff in a trademark infringement case under the Lanham Act need prove that Defendant's infringement was in a commerce over which Congress had power to regulate, provided the Plaintiff in such case proved that the infringement caused confusion as to origin of Defendant's products.

4. The Court held in its opinion as follows:

a. By affirming the decision of the Lower Court it affirmed the Lower Court's finding that there was no monetary loss to the good-will or business of the Plaintiff.

b. The good-will and reputation of the trade-mark were damaged by reason of confusion.

The Court overlooked and failed to take into consideration:

a. In such finding it has established a property right in a name.

b. It has separated the name from the orange juice business which it identifies by holding that although the latter was not damaged as found by the district court, the former was.

c. It has failed to recognize the general rule in both Florida and the Federal Courts holding there is no property right in a name. *Children's Bootery v. Sutker*, (Fla.) 107 So. 345, opinion written by the late Judge Strum who was then a Justice of the Supreme Court of Florida. *Lawyers Title Ins. Co. v. Lawyers Title Ins. Corp.* (D. C.) 109 F.2d. 35, Certiorari denied, 309 U.S. 684, 84 L. Ed. 1028, 60 S. C. 806. This opinion was written by Associate Justice Rutledge of the United States Supreme Court while he was sitting as a justice of the Circuit Court of Appeals for the District of Columbia. *S. C. Johnson & Son v. Johnson*, 116 F.2d. 427, 175 F.2d. 176, Certiorari denied 388 U.S. 860, 94 L. E. 527, 70 S. C. 102. In this last case which was one seeking to protect a trade-mark against imitations in a market which the Plaintiff had not entered, Judge Learned Hand warned:

"There is always the danger that we may be merely granting a monopoly, based upon the notion that by advertising one can obtain some "property" in a name. We are merely sure to go astray in any phase of the whole subject, as soon as we lose sight of the underlying principle that the wrong involved is diverting trade from the first user by misleading customers who mean to deal with him."

5a. The Court has based its opinion that it has jurisdiction upon the finding of fact of confusion by the district court. The failure to raise the question of jurisdiction in the district court is immaterial, as jurisdiction cannot be conferred by judicial interpretation, prior action, or consent of the parties. *American Fire & Cas. Co. v. Finn*, 341 U.S. 6, 95 L. E. 702. In this last case the one who invoked the jurisdiction of the Federal Court by petition to remove from the state court subsequently successfully attacked the jurisdiction of the court. There is no evidence upon which the district court could legally have found that there was confusion. The only testimony was that of several housewives who stated, after being visited by counsel for Plaintiff the night before the trial, that they had been confused as to the source of origin of Defendant's goods when purchasing the same. A narrative statement made post litem motam as to a past state of mind is not competent legal evidence. 31 C. J. S. 1005-1006 and cases there cited.

6. Under the case of *Erie v. Thompkins* the law of Florida and not the Federal law controls the question of a trade-mark infringement where the trade-mark is used only in intrastate commerce. Note 148 A. L. R. 160 and

cases there cited. Under the law of Florida as shown by Judge Strum's opinion a name alone will not be protected in the absence of pecuniary damage to that which it identifies.

Respectfully submitted,

J. M. FLOWERS
Attorney for Appellant
1023 Alfred I. duPont Building
Miami, Florida

ORDER DENYING REHEARING

Extract from the Minutes of August 31, 1954.

PURE FOODS, INC.

No. 14805 versus

MINUTE MAID CORPORATION.

It is ordered by the Court that the petition for rehearing filed in this cause be, and the same is hereby, denied.

9/20

FILED
NOV 5 1954
HAROLD B. WILLEY, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1954

No. 392

PURE FOODS, INC.,
Petitioner,

v.

MINUTE MAID CORPORATION,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

J. THOMAS GURNEY,
Counsel for Respondent,
413 First National Bank Building,
Orlando, Florida.

RALPH L. CHAPPELL,
Of Counsel.

APPEAL PRINTING CO. INC., 130 CEDAR ST., NEW YORK, WORTH 4-3033

INDEX

	PAGE
OPINIONS BELOW	1
JURISDICTION	1
QUESTIONS PRESENTED FOR REVIEW	1
STATUTES INVOLVED	2
STATEMENT	2
STATEMENT OF FACTS	3
ARGUMENT	4
POINT I—The record does not support defendant's contentions as to the questions presented for review	4
POINT II—There is no conflict with the decision of the Court of Appeals for the Second Circuit in the Spiegel case	7
POINT III—There is no conflict with the decision of the Court of Appeals for the Seventh Circuit in the Sunkist case	10
CONCLUSION	13

Table of Cases Cited

American Auto Association et al. v. *Spiegel*, 205 F. (2d) 771 (2d Cir., 1953)	8, 9
Aunt Jemima Mills Co. v. *Rigney & Co.*, 247 F. 407 (2nd Cir., 1917)	5

PAGE

California Fruit Growers Exchange v. *Sunkist Baking Co.*, 166 F. (2d) 971 (7th Cir.) 10, 12

Cole of California, Inc. v. *Collette of California, Inc.*, 79 U.S.P.Q. 267 (D.C. Mass., 1948) 5

S. C. Johnson & Son v. *Johnson*, 116 F. (2d) 427 (2nd Cir.) 1940 12

S. C. Johnson & Sons, Inc. v. *Johnson et al.*, 175 F. (2d) 176 13

Staufer v. *Exley*, 184 F. (2d) 962 (Cir., 1950) 9

Steele v. *Bulova Watch Co., Inc.*, 344 U. S. 280 (1952) 5

Wall v. *Rolls-Royce of America*, 4 F. (2d) 333 (3rd Cir., 1925) 5

Wickard v. *Filburn*, 317 U. S. 111 (1942) 6

Yale Electric Corporation v. *Robertson*, 26 F. (2d) 972 (2d Cir., 1928) 5

Statutes

A. L. I. Restatement of the Law of Torts, Vol. 3, Sec. 730, p. 597 7

A. L. I. Restatement of the Law of Torts, Vol. 3, Sec. 744, p. 631 6

The Lanham Act, 15 U.S.C. 1051—Sec. 1 ..... 2, 6

The Lanham Act, 15 U.S.C. 1114—Sec. 32 7

1905 Trade Mark Act, 15 U.S.C.A., Sec. 96 11

IN THE

Supreme Court of the United States

OCTOBER TERM, 1954

No.

PURE FOODS, INC.,
Petitioner,

v.

MINUTE MAID CORPORATION,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Opinions Below

The opinion of the District Court (Appendix of Petition, pages 16 and 17) is not reported. The opinion of the Circuit Court of Appeals for the Fifth Circuit (Appendix of Petition, pages 15-23) is not yet reported.

Jurisdiction

The jurisdictional requisites are adequately set forth in the Petition.

Questions Presented for Review

1. Does a Federal Court have jurisdiction to enjoin infringement of a trade mark registered under the Lanham Act where the acts of infringement occurred intrastate but had a substantial economic effect on interstate commerce to and from the state by causing confusion as to the source of origin of the infringer's goods?

2. Can the owner of a trade mark registered under the Lanham Act enjoin the use of the trade mark on different but closely related products when as a fact the use by the defendant has caused confusion and mistake on the part of purchasers as to the source of origin of the defendant's products, and the use is likely to continue to cause confusion and mistake in the minds of the general public?

Statutes Involved

In addition to the sections of the Lanham Act, 15 U.S.C. 1051 *et seq.*, which are set forth at pages 5 and 6 of the Petition, the following portion of that Act is involved.

15 U.S.C. 1051:

> "The owner of a trade-mark used in commerce may register his trade-mark under this Act on the principal register hereby established:
>
> (a) By filing in the Patent Office—
>
> (1) a written application, in such form as may be prescribed by the Commissioner, verified by the applicant, or by a member of the firm or an officer of the corporation or association applying, specifying applicant's domicile and citizenship, the date of applicant's first use of the mark, the date of applicant's first use in commerce, the goods in connection with which the mark is used and the mode or manner in which the mark is used in connection with such goods, * * *."
>
> (Other portions of Section omitted as not pertinent.)

Statement

This is an action for infringement of a trade mark registered under the trade mark laws of the United States.

The petitioner invokes jurisdiction on the grounds that the decision of the Court of Appeals is in direct conflict

with certain decisions of other Courts of Appeal, and on the ground that the record presents an important question of Federal Law, which has not been settled.

An examination of the record shows that petitioner's contentions are not accurate. There is no conflict of decision, and there is no unsettled important question of Federal Law.

The petitioner urges that certain questions are presented for review. These questions are not raised on the record.

Statement of Facts

Plaintiff is the owner of the Federally registered trade mark "Minute Maid" applied to frozen fruit juice concentrates. It has used the mark in Interstate Commerce to and from the State of Florida.

Defendant has used the trade mark "Minute Made" on frozen meat products.

Plaintiff has advertised extensively, and as the courts below find, has acquired a secondary meaning for its trade mark "Minute Maid" in the minds of the public, as denoting products produced and sold by the plaintiff. (See Finding 13, Tr. 13.)

The courts below found that the defendant's use of the words, "Minute Made" has caused confusion and mistake on the part of purchasers as to the source of origin of defendant's products, and that the use of such words is likely to continue to cause confusion and mistake in the minds of the general public. (See Finding 14, Tr. 13.) This was supported by extensive testimony of housewives. (Tr. 64-70, 89-93, 103-108, 109-114, 129-136.)

The District Court found that there was no proof of actual "monetary" damage or injury as a result of defendant's actions to the good will of the business of the plaintiff.

In line with these findings, the District Court enjoined further infringement, but since there was no finding of "monetary" loss, denied an accounting.

On defendant's appeal, the Court of Appeals affirmed the District Court.

ARGUMENT

POINT I

The record does not support defendant's contentions as to the questions presented for review.

Defendant contends that the record presents a case in which Federal jurisdiction cannot be invoked because defendant's infringement of plaintiff's trade mark did not have any substantial economic effect on Interstate Commerce.

The record does not substantiate this contention, because it shows that defendant's infringement in Intra-State Commerce of plaintiff's registered trade mark did and will have a substantial economic effect on plaintiff's Interstate Commerce under the trade mark. Both courts below agreed that by causing confusion as to the source of original of its products through trade mark infringement, defendant has and will, unless enjoined, injure plaintiff's good will in Interstate Commerce.

The fact that there is no proof of "monetary" injury does not mean that there is not substantial economic effect on Interstate Commerce, and on plaintiff's good will in such commerce. It is well recognized in trade mark law that injury which cannot be measured in dollars or prospective injury to good will, is a substantial economic effect, justifying the granting of an injunction even without proof of actual "monetary" damage.

By creating confusion as to source of origin, the defendant has materially affected plaintiff's interstate business under its registered trade mark.

In *Steele* v. *Bulova Watch Co. Inc.*, 344 U. S. 280 (1952), this Court held that prospective injury to the plaintiff's trade reputation resulting from spurious "Bulovas" which had filtered through the Mexican border into the United States sufficiently affected plaintiff's interstate commerce to bring into play Federal jurisdiction under the Lanham Act. This court said, page 286:

> "* * * In the light of the broad jurisdictional grant in the Lanham Act, we deem its scope to encompass petitioner's activities here. His operations and their effects were not confined within the territorial limits of a foreign nation. He brought component parts of his wares in the United States, and spurious 'Bulovas' filtered through the Mexican border into this country; his competing goods could well reflect adversely on Bulova Watch Company's trade reputation in markets cultivated by advertising here as well as abroad."

There is also a great mass of authority holding that prospective injury caused by infringement on different goods does substantially affect the good will of a trade mark owner. *Cole of California, Inc.* v. *Collette of California, Inc.*, 79 U. S. P. Q. 267 (D. C. Mass., 1948); *Yale Electric Corporation* v. *Robertson*, 26 F. (2d) 972 (2d Cir. 1928); *Aunt Jemima Mills Co.* v. *Rigney & Co.*, 247 F. 407 (2d Cir., 1917); *Wall* v. *Rolls-Royce of America, Inc.*, 4 F. (2d) 333 (3rd Cir., 1925).

Under the *Bulova* case and these cases it was not necessary to show actual "monetary" loss. They recognize injury even if it is not capable of computation in dollars—and such injury in the *Bulova* case sustained jurisdiction under the Lanham Act.

The petitioner contends that in finding that there was no proof of actual monetary damage or injury the court has in fact found that the infringement does not affect Interstate Commerce substantially.

This contention is well answered in the opinion of the Court of Appeals in this case, where the court points out that the court did not find that there was no damage, or likelihood of damage, but merely found that there was no proof of actual monetary damage to warrant the court in ordering an accounting. Paragraph 3 of page 14 of the Transcript of Record supports this statement but it does not support the petitioner's statement on page 8 of the petition that the District Court found that the plaintiff had suffered no damages.

It is difficult for the owner of a trade mark to prove the amount of damage. It is not necessary in order to obtain an injunction that there be proof of actual damage. It is only necessary to show likelihood of damage such as is shown in this case, where the plaintiff's good will is placed at the hazard of defendant's operations and in defendant's hands. A.L.I. Restatement of the Law of Torts, Volume 3, Section 744, page 631.

Apparently, defendant is under the impression that the Federal Courts cannot have jurisdiction unless there are substantial "monetary" involvements. This thought should be dissipated by the decision of this Court in *Wickard* v. *Filburn,* 317 U. S. 111 (1942), where this Court enforced quota penalties against a farmer who did not sell his wheat in either Interstate or Intra-State Commerce, but merely consumed it on his own farm. He planted 11.9 excess acres, and only 239 bushels of wheat were involved. Certainly, defendant's infringement, and its effect on Interstate Commerce, is as great.

Defendant contends also that the record presents an important question of law as to whether a registered trade mark is limited solely to the products which are listed in the registration.

Section 1 of the Lanham Act, 15 U.S.C., 1051, provides that the owner of a trade mark may register it by filing an application which states the goods in connection with which the mark is used. This section does not

say that such a statement shall be construed as a limitation of the rights of the owner of the trade mark to remedies only against the use of the trade mark on the specific goods.

Section 32 of the Lanham Act, 15 U.S.C., 1114 (1) provides that any person who uses a reproduction counterfeit copy, or colorable imitation of a registered mark in connection with the sale of goods in connection with which such use is likely to cause confusion or mistake, or to deceive purchasers as to the source of origin of such goods, shall be liable to civil action by the registrant for the remedies provided by the law.

The Trade Mark Law itself clearly disposes of the defendant's contention. It gives a remedy which is specifically wider than the statement in the registration.

In this respect, the Lanham Act is in step with the common law, which is well summed up in the following statement from the A.L.I. Restatement of Law of Torts, Volume 3, Section 730, page 597, which is quoted by the Court of Appeals in this case:

> "One's interest in a trade-mark or trade name came to be protected against simulation, * * * not only on competing goods, but on goods so related in the market to those on which the trade-mark or trade name is used that the good or ill repute of the one type of goods is likely to be visited upon the other. Thus one's interest in a trade-mark or trade name is protected against being subjected to the hazards of another's business."

POINT II

There is no conflict with the decision of the Court of Appeals for the Second Circuit in the *Spiegel* case.

In the present case the plaintiff is engaged in Interstate Commerce to and from Florida under its trade mark "Minute Maid". The defendant is engaged in

Intra-State Commerce in Florida. The lower courts found that defendant's sale of its product under the infringing mark has caused confusion and mistake on the part of purchasers as to the source of origin of defendant's products, and that continued use of defendant's trade mark is likely to continue to cause confusion.

In *American Auto Association, et al.* v. *Spiegel,* 205 F. 2nd 771 (2nd Cir. 1953), the plaintiff had a registered trade mark, "A.A.A." covering various articles, including maps, which it distributed gratis. The defendant ran a filling station where it sold gasoline and distributed maps to its customers. It displayed plaintiff's trade mark, "A.A.A." on its station.

On the record before it, the court was unable to find that defendant's use of plaintiff's trade mark, "A.A.A." on its station had created any confusion as to source of origin. The court, however, did not dismiss the Complaint, but merely reversed the lower court's summary judgment and remanded the case to the District Court, saying (pp. 773-4):

> "However, even if we were to accept his distribution of them as a 'sale', by no possibility could we hold that the customers were 'likely' to suppose that they came from the plaintiffs. The only evidence is that the defendant received the maps he gave away from the Socony Vacuum Company, and presumably they bore on their face that company's name. Be that as it may, it is quite untenable to suppose that, because he displayed the plaintiff's mark in front of his station, his customers were led to think that the plaintiffs were the source of the maps. Possibly upon a trial that may be made to appear, but this record does not give the slightest warrant for any such conclusion. Not only was there no support for a finding of infringement, but the claim was too 'unsubstantial' to support the defendant jurisdiction over the claim for 'unfair competition'. If the judgment is to stand,

it must rest in some other section of the Act than §1114(1)(a)."

It is significant that the Court of Appeals did not dismiss the Complaint for want of infringement in commerce, even though the defendant's business was a strictly local and intra-state operation of a single filling station. In its decision, the Court of Appeals recognized that if on the trial the plaintiff could show that there had been confusion as to the source of origin of the maps distributed by the defendant, the court would have jurisdiction under the Lanham Act.

There is certainly no conflict between the decision of the Court of Appeals in the present case, and the decision in the *Spiegel* case.

The petitioner tries to make it appear that the Court of Appeals in this case adopted the broad interpretation of the Lanham Act adopted by the Court of Appeals for the 9th Circuit in *Staufer* v. *Exley,* 184 F. 2nd, 962 (Cir. 1950), and was in conflict with the decision of the Second Circuit Court of Appeals in the *Spiegel* case. That is not the case. The Court of Appeals in the present case held that the defendant's intra-state infringement substantially affected plaintiff's interstate commerce under its registered trade mark, and that, therefore, the Lanham Act conferred jurisdiction.

The Court of Appeals in the present case rejected the sweeping extension of Federal jurisdiction to all instances of unfair competition with interstate commerce, and commented specifically upon Judge Learned Hand's decision in the *Spiegel* case as a well-considered one.

It is not necessary in the present case to rely upon any broad jurisdictional grant under the Lanham Act and the court below did not do so.

POINT III

There is no conflict with the decision of the Court of Appeals for the Seventh Circuit in the *Sunkist* case.

Both courts below based their decision on the specific finding that defendant's use of the words "Minute Maid" has caused and is likely to cause confusion as to the source of origin of defendant's products.

This finding was based upon the testimony of a number of housewives as to their actual confusion and mistake in buying defendant's products on their faith in the plaintiff's reputation.

In this respect the present case differs from *California Fruit Growers Exchange* v. *Sunkist Baking Co.*, 166 F. 2nd 971 (7th Cir.). In that case there were two plaintiffs. One used the trade mark on jellies. The other used it on fruits. The defendant used it on bakery products.

The Court of Appeals dismissed the complaint because there was neither a finding that the defendant's use of the mark caused or was likely to cause confusion and mistake on the part of the purchaser as to the source of origin of defendant's products, nor any evidence to support such a finding. The Court of Appeals said, page 973:

> "The court did not find that there is any likelihood of confusion as to the origin of the bakery products."

The Court said later, page 974:

> "We do not think there is a finding that there is likelihood of confusion as to the source of origin of the products, as required by the Lanham Act."

The Court then said, page 975:

> "Thus we have the speculative opinion of the vice president of one plaintiff and the advertising man-

ager of the other as to what the purchaser would likely think. No prospective purchaser gave any such opinion. Indeed, the many housewives called were not in the least confused. We think the evidence of these two so-called experts is so unsubstantial as to afford no support for the so-called finding that by the defendants' use of 'Sunkist' on their bakery products, such products would naturally or reasonably be supposed to come from the plaintiffs. In any view of this case, the record is wholly devoid of any finding, or substantial evidence to support a finding, of a likelihood of confusion as to the source of origin, as required to constitute infringement under the Lanham Act."

In reaching this conclusion, the Court pointed out that the District Court's finding that defendant's use of the mark was likely to cause confusion or mistake in the minds of the public and that the goods were of substantially the same descriptive properties might have satisfied the requirements of the 1905 Trade Mark Act, 15 U.S.C.A. §96, but that it did not satisfy the requirement of the Lanham Act that there be confusion on the part of the purchaser as to the source of origin of the defendant's products.

The Court rejected the opinion evidence of officials of the plaintiff that there might be conflict and as pointed out in the above quoted portion of the opinion and relied upon the testimony of housewives that they were not in the least confused.

The Court also commented that in its opinion no one with an I.Q. high enough to be regarded by law would ever be confused in the purchase of bread bearing the trade mark because someone else sold fruits and vegetables under the same trade mark. The Court said that it was unable to see how anyone seeking to purchase bread would be confused as to the source of origin of such bread.

The Court's conclusion was reinforced by the fact that the two plaintiffs had agreed that there would be no confusion between their own products, namely, jellies and fruits, and properly concluded that with such a situation confronting the Court, it would be difficult to see how bread, which has greater differences from either jellies or fruits, than jellies or fruits have from one another, could possibly lead to confusion as to the source of origin.

There is no conflict between the present case and the *Sunkist* case. Both recognize that if there is a finding supported by evidence, that there has been or is likelihood to be confusion and mistake on the part of purchasers as to the source of origin of the defendant's product, the plaintiff is entitled to relief under the Lanham Act.

The petitioner contends that the dictum in the *Sunkist* case quoted on page 12 of the petition is at odds with the decision of the Courts in this case. This contention ignores the holding of the *Sunkist* case and the reasoning of the Court in arriving at its conclusion.

The decision of the Court in the present case is strictly in accordance with the Lanham Act, which requires the registrant of a trade mark to state the goods on which he has used the mark, but which does not confine his protection to the specific goods, but gives the trade mark owner protection against the use of his mark on other goods where such use will cause confusion and mistake on the part of the purchaser as to the source of origin of the infringer's goods.

Petitioner calls attention specifically to the case of *S. C. Johnson & Son* v. *Johnson,* 116 F. 2nd 427 (2nd Cir.), 1940. This case was decided before the passage of the Lanham Act and was a holding that a defendant named Johnson had a right to use his name on a household cleaner even though the plaintiff had used the name extensively on floor wax in spite of some confusion.

After the passage of the Lanham Act, the plaintiff, The Johnson Wax Company, registered "Johnson" under the

Lanham Act and tried again to enjoin the defendant's used of "Johnson" on his household cleaner. The decision of the Court is reported, *S. C. Johnson & Sons, Inc.* v. *Johnson, et al.*, 175 F. 2nd 176. The Court again refused to enjoin the use by the defendant of the name "Johnson" because of his interest in using his own name. In arriving at its conclusion that the application of the Statute to surnames was not absolute, the Court said, page 180:

> "If Congress really meant to allow every first user of a mark so to stifle all excursions into adjacent markets upon showing no more than that confusion would result, it seems to us that it would have said so more clearly. In the case of fabricated marks which have no significance, save as they denote a single source or origin of the goods to which they are attached, the first user's right may indeed go so far. The second user can then show no interest of his own; and if, as will then appear, his only purpose is to trade on the first user's good-will, it is indeed time to intervene. That situation is polar to this, and we do not believe that both have been swept into a common condemnation by the language used to create the new federal right."

The Court thus recognizes that in cases such as the present, which are not complicated by the defendant's desire or right to use his own surname, the language of the Lanham Act is controlling. The question of the surname is not presented in this case, and there is no conflict between the present case and the *Johnson* cases.

Conclusion

There is no reason for the grant of Certiorari in this case. It does not present any unsettled questions of law, and there is no conflict between the decision below, and the decisions of other courts.

The decision of the court below is in accordance with the statutes and controlling decisions of this and other courts.

The Petition for Certiorari should be denied.

Respectfully submitted,

J. THOMAS GURNEY,
Counsel for Respondent.

RALPH L. CHAPPELL,
Of Counsel.

November 4, 1954.

Certificate of Mailing

I do hereby certify that the above and foregoing Respondent's Brief in Opposition to Petition for Writ of Certiorari was served upon William C. Martin, Esq., 701 Congress Building, Miami, Florida, and upon Joe Creel, Esq., 701 Congress Building, Miami, Florida, as Attorneys for Petitioner, by depositing the same properly addressed in a United States mail box, with air mail postage prepaid, this 4th day of November, 1954.

RALPH L. CHAPPELL,

Ralph L. Chappell,
Of Counsel for Respondent.